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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/852,810	05/10/2001	Brian R. Gareau	00-762	5489

719 7590 09/22/2005

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 PATENT DEPT.  
 PEORIA, IL 616296490

EXAMINER
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MEINECKE DIAZ, SUSANNA M

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/852,810

Applicant(s)

GAREAU ET AL.

Examiner

Susanna M. Diaz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 13-15, 20-22, 27-29, 34-36, 38 and 40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12, 16-19, 23-26, 30-33, 37 and 39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10/16/02.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This non-final Office action is responsive to Applicant's election filed June 23, 2005.

Applicant has elected Group I and has amended claim 6 such that claims 6-8 are now part of Group I.

Claims 13-15, 20-22, 27-29, 34-36, 38, and 40 stand as non-elected claims.

Claims 1-12, 16-19, 23-26, 30-33, 37, and 39 are presented for examination.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-12, 16-19, 23-26, 30-33, 37, and 39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claim 1 only recites one step as being optionally performed by a computer (i.e., "collecting by at least one of computer and a user"). This means that all steps recited throughout claims 1-8 may be entirely performed by a human. This creates a problem with steps that are open to a wide range of subjectivity depending on the particular human carrying out the step, his/her mood, etc. For example, the scope of determining at least one of themes and issues..., determining at least one action corresponding to the one of themes and issues..., implementing the at least one action..., assessing an effect of said implementing step..., and determining at least one

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additional action (claim 1) are not subjected to any clear-cut metes and bounds, e.g., as imposed by quantifiable calculations, etc. A similar analysis applies to all of the steps of claims 2-4 and 8. For example, as per claim 4, who or what establishes the standards to determine whether or not communication between employees and managers are ineffectual? Without the specifics of the measures imparted by quantitative feedback and their limit to meaningful and useful values and corresponding analyses, related analyses are not useful, concrete, or tangible.

While claims 6 and 7 recite that averages of the responses to the quantitative questions collected from the at least one individual interview and the at least one focus group meeting are calculated in order to determine themes and issues by comparison of the calculated averages, the claim does not specify what the determining is based on. There is no express methodology for generating reproducible results, especially since a human may make a subjective determination. Furthermore, what do these averages represent? At present, they are so broadly recited that their usefulness is questionable. Consequently, the metes and bounds of claims 6 and 7 are questionable depending on the scope of freedom and subjectivity that a human may impart to the method.

Claims 16-19 and 37 recite method claims with limitations similar to those recited in claims 1-8; therefore, the same rejections apply.

Claims 9-12 and 39 recite apparatus claims with limitations similar to those recited in claims 1-8; therefore, the same rejections apply. Furthermore, claims 9-12 and 39 are written in means-plus-function format. Looking toward the specification, it is not clear whether or not Applicant intended each means to correspond to a computer or

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human. Means-plus-function language requires corresponding structural limitations in the specification; however, the specification discloses that a human user performs many of the recited functionality. For example, does the computer actually determine at least one of theme and issues by analyzing the compiled data or does the computer merely sort the data to then allow a human user to perform the analysis (claim 9)? Similarly, does the computer actually assess an effect made by the implementation of at least one action on the organization (claim 9) and determine ineffectual communication as a theme (claim 12) or does it merely sort the data so that a human user may more easily perform the assessment and determination? Additionally, how can the computer cause the at least one action to be implemented on the organization (claim 9)? This appears to be a function mandated by a human user(s).

Claims 23-26 recite a system comprising a computer program product with limitations similar to those recited in claims 1-12, and 39; therefore, the same rejections apply. Please note that the issues of which steps are actually meant to be performed by a computer versus a human (raised more explicitly in claims 9-12 and 39) are especially pertinent to the discussion of claims 23-26.

Claims 30-33 recite a system comprising an executable signal embodied in a carrier wave with limitations similar to those recited in claims 1-12, and 39; therefore, the same rejections apply. Please note that the issues of which steps are actually meant to be performed by a computer versus a human (raised more explicitly in claims 9-12 and 39) are especially pertinent to the discussion of claims 30-33.

Appropriate correction and/or clarification is required.

***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-12, 16-19, 23-26, 30-33, 37, and 39 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble. Mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

As discussed in the rejections of claims 1-12, 16-19, 23-26, 30-33, 37, and 39 under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph above, the usefulness, concreteness, and tangibility of the claimed invention have been placed into question. Furthermore, the extent of integration of technology is not yet clear. Until these issues are remedied under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph, a corresponding rejection under 35 U.S.C. § 101 is asserted as well.

Appropriate correction is required.

*Because claims 1-12, 16-19, 23-26, 30-33, 37, and 39 are so indefinite, no art rejection is warranted as substantial guesswork would be involved in determining the scope and content of these claims. See In re Steele, 305 F.2d 859, 134 USPQ 292 (CCPA 1962); Ex parte Brummer, 12 USPQ 2d, 1653, 1655 (BdPatApp&Int 1989); and also In re Wilson, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970).*

### **Conclusion**

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (571) 272-6733. The examiner can normally be reached on Monday-Friday, 10 am - 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Susanna M. Diaz  
Primary Examiner  
Art Unit 3623

September 17, 2005